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10/786,706	02/25/2004	Paul Swenson	01841-22363.NP	3682
20551 7590 08/26/2010 THORPE NORTH & WESTERN, LLP. P.O. Box 1219 SANDY, UT 84091-1219				
EXAMINER				
FIELDS, BENJAMIN S				
ART UNIT		PAPER NUMBER		
3684				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/786,706

Applicant(s)

SWENSON ET AL.

Examiner

BENJAMIN S. FIELDS

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,11-18,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11-18,20 and 21 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Introduction

1. A **request for continued examination (RCE)** under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), **was filed** in this application **AFTER FINAL rejection**. Since this application is **eligible** for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the **FINALITY** of the previous Office action has been **WITHDRAWN** pursuant to 37 CFR 1.114. Applicants submission filed on 17 August 2010 has been entered.
2. The following is a **FINAL** Office Action in response to the communication received on 17 August 2010. Claims 1-2, 4-9, 11-18, and 20-21 are now pending in this application.

Response to Amendments

3. The Examiner acknowledges the Applicants remarks regarding the originally asserted 35 U.S.C. 101 Rejection of Claims 1-9, 11-18, and 20-21, however, the Examiner maintains the rejection in view of the comments mentioned below. Reference the comments made within the section labeled 35 U.S.C. 101 Rejections below.
4. The Examiner acknowledges the Applicants amendments to Claims 1 and 21 in regards the originally asserted 35 U.S.C. 112 1st Paragraph Rejection. As such, the Examiner has removed the 35 U.S.C. 112 1st Paragraph Rejections.
5. The Examiner acknowledges the Applicants amendments to Claims 1 and 21 in regards the originally asserted 35 U.S.C. 112 2nd Paragraph Rejection. Although the Applicants have amended the claims, the Examiner has noticed further 35 U.S.C. 112

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2nd Paragraph Rejections in view of the amendments made in efforts to overcome the currently outstanding 35 U.S.C. 112 2nd Paragraph Rejections (Please reference the new 35 U.S.C. 112 2nd Paragraph Rejections below).

6. Applicants Amendments to Claims 1-9 and 11-21 has been acknowledged in that: Claims 1-2, 4-7, 11-12, and 20-21 have been newly amended; Claims 3 and 19 have been newly cancelled; NO Claims have been newly added; hence, as such, Claims 1-2, 4-9, 11-18, and 20-21 are pending in this application.

Claim Objections

7. Claim 1 is objected to because of the following informality:

Referring to Claim 1: Claim 1 (at line 3) contains information directed towards the specification of the application, that of which should not be within the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims **1-2, 4-9, 11-18** and **20-21** are rejected under 35 U.S.C. 101 because the claimed invention is not directed to a secondary statutory subject matter/class.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at

70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines. '); Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' '); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').⁷ A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article." (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

As noted in *Bilski*: "[A] Process claim that recites fundamental principle, and that otherwise fails 'machine-or-transformation' test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere 'insignificant post-solution activity.'" (*In re Bilski*, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)) Examples of insignificant post-solution activity include data gathering and outputting. Furthermore, the machine or transformation must impose meaningful limits on the scope of the method claims in order to pass the machine-or-transformation test. Please refer to the USPTO's "Guidance for Examining Process Claims in view of *In re Bilski*" memorandum dated January 7, 2009, http://www.uspto.gov/web/offices/pac/dapp/opla/documents/bilski_guidance_memo.pdf .

Point of Importance: It is also noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion *Ex parte Langemyr et al.* (Appeal 2008-1495), <http://www.uspto.gov/web/offices/dcom/bpai/its/fd081495.pdf> .

Furthermore, Claims 1-2, 4-9, 11-18 and 20-21 are not directed toward statutory subject matter. The claims are directed toward a charitable cause, movement, or expression which incites feelings within individuals. Gathering flags is the only functionality that is positively recited. The Applicants have argued that a transformation occurs in that the flags are posted and continually removed and altered. The Examiner does not agree that this is a physical transformation which satisfies any of the grounds of the 35 U.S.C. 101 statutes.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to Claims 11-12: Claims 11-12 recite the limitations: " ... obtaining a person, [and] ... obtaining an organization ... ".

The Examiner notes that such limitations per Applicants require clarification. It is not clear how one can “obtaining a person, [and] ... obtaining an organization”?

Appropriate correction is required.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-2, 4-9, 11-18, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Exhibit U in view of Harmon et al. (US PG Pub. No. 2004/0181468), [hereinafter Harmon].

Evidence of public use and knowledge of the invention prior to Applicant's earliest priority date of 6 February 2004 is provided as follows:

EXHIBIT	DESCRIPTION
U	FREEDOM FIELD <URL: http://www.bright.net > [online], March 2001 [retrieved on 2005-04-11]. Retrieved from the Internet: <URL: http://www.archive.org >

This evidence, taken as a whole, shows that the invention, as claimed, was both in "public use" and "knowledgeable" prior to 6 February 2004.

Referring to Claims 1 and 20-21: Exhibit U teaches a method for raising funds for a charitable cause comprising the steps of: identifying a charitable cause in need of funding (Exhibit U: Pages 1-2//The need for funding here is represented by assisting troops across the country//); selecting a graphic layout for a healing field that is comprised of a plurality of flags positioned in a predetermined pattern (Exhibit U: Pages 1-2, 4-5); transforming a selected location by erecting the plurality of flags at the selected location to comprise the healing field (Exhibit U: Pages 1-2, 5); linking a display of the healing field to the charitable cause in need of funding by carrying out a public awareness campaign to associate the charitable cause with the healing field (Exhibit U: Pages 1-2); displaying the healing field as part of the public awareness campaign, and selling at least some of the plurality of flags that are displayed in the healing field after a predetermined display period to raise additional funds for the charitable cause in need of funding, and thereby removing the plurality of flags from the selected location (Exhibit U: Pages 1-2, 4-5).

Exhibit U, however, does not expressly discuss obtaining one or more sponsors to fund the charitable cause through paying for the plurality of prior to their display.

Harmon, in a similar environment, shows multiple fund raising events (a healing field is an example of such type of fundraising event) temporarily occupying a location (for a period of time) not dedicated to providing a permanent display (Harmon: Page 1, Paragraphs 0004-0008); obtaining one or more sponsors to fund the charitable cause through paying for the plurality of prior to their display (Harmon: Figure 2; Page 1, Paragraphs 0004-0008; Claims 1-3). Further, regarding removing the plurality of flags after a predetermined display period to eliminate the healing field from the location, the Examiner notes that this would obviously take place if the healing field even were held at certain times of the year or at certain locations, etc.

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the method of Exhibit U with the features causing the charity fund raising event to be periodic/temporary and allowing at least a portion of proceeds to go to the charitable cause in need of funding for the purpose of further inhibiting charitable giving and create better manners to solicit funds for charitable causes/events (Harmon: Page 1, Paragraphs 0002-0008).

Referring to Claim 2: Exhibit U discloses a method, wherein the step of designating the graphic layout for the healing field further comprises the step of identifying a historical event to be symbolized by the plurality of flags (Exhibit U: Pages 1-2, 4-5//The 'historical event' mentioned is the support which will be provided by assisting in this/these efforts is/are shown//).

Referring to Claim 4: Exhibit U discloses a method, wherein the predetermined pattern could be that of a geometric nature (Exhibit U: Pages 1-2, 5//The reference

discloses plans for a "Field of Honor" containing over one-hundred granite memorial markers, as well as a "Flags of Freedom Monument" containing state and colonial flags located around 5 pools forming the shape of a star//).

Referring to Claim 5: Exhibit U teaches a method, wherein the predetermined pattern could be that of a linear array placed along an area selected from the group consisting of a path, a body of water, a river, a building, a structure, a road, a highway, a trail, a hill, a mountain, and a military base (Exhibit U: Pages 1-2, 5).

Referring to Claim 6: Exhibit U discloses a method further comprising the step of incorporating information within the predetermined pattern (Exhibit U: Pages 1-2, 5).

Referring to Claim 7: Exhibit U shows a method, further comprising the step of incorporating a graphic message within the predetermined pattern (Exhibit U: Pages 1-2, 5).

Referring to Claim 8: Exhibit U discloses a method, wherein the step of linking a display of the healing field to the charitable cause further comprises the step of advertising a purpose for the plurality of flags and the healing field, wherein the purpose links the plurality of flags and the healing field to the charitable cause (Exhibit U: Pages 1-2, 4-5//The website disclosed herein serves as a means of advertisement for such a charitable cause//).

Referring to Claims 9 and 17-18: Exhibit U in view of Harmon teaches the limitations of Claim 1.

Exhibit U in view of Harmon, however, does not expressly discuss a method, wherein the step of advertising the purpose for the plurality of flags and the healing field

further comprises the step of advertising through a medium selected from the group consisting of radio stations, television stations, newspapers, magazines.

The Examiner notes that advertising via the means selected from the group consisting of radio stations, television stations, newspapers, magazines are common, old, and well known in the art. Exhibit U itself shows internet advertising and in some respect features either radio and television, advertising (See the message from Commander-in-Chief mention). Therefore, it would be obvious to utilize, in addition to the present website, additional avenues of promoting (i.e. radio stations, television stations, newspapers, magazines) the healing field fundraising event.

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the method and system of Exhibit U for a flag healing field fundraising event with an even greater ability to promote this fundraising event via radio stations, television stations, newspapers, and/or magazines for the purpose of enabling a vast majority of people to support such a charitable cause (Exhibit U: Pages 4-5).

Referring to Claims 11-12: Exhibit U shows a method, wherein [obtaining] the one or more sponsors further comprises [obtaining] a person that pays to sponsor one or more flags in the plurality of flags (Exhibit U: Pages 1-2, 4-5//The sites allow an individual, company, and/or organization to sponsor the fundraising event//).

Referring to Claim 13: Exhibit U teaches a method, wherein the step of selling the plurality of flags further comprises the step of selling the plurality of flags through an auction (Exhibit U: Pages 4-5//The site composes an auction type feature/functionality

which allows sponsorship of the fundraising event in that a bid or purchase price has been established and agreed upon once the healing field goes into effect//).

Referring to Claim 14: Exhibit U discloses a method, wherein the auction is an internet auction (Exhibit U: Pages 4-5//The site is accessible via the internet//).

Referring to Claim 15: Exhibit U shows a method, wherein the step of selling the plurality of flags further comprises the step of selling the plurality of flags through an advertising campaign (Exhibit U: Pages 1-2, 4-5//The site is an advertising campaign//).

Referring to Claim 16: Exhibit U discloses a method, wherein the step of selling the plurality of flags further comprises the step of placing advertisements near the healing field (Exhibit U: Pages 1-2, 4-5//The usage of the site is the main avenue for sales for the fundraising campaign, however, additional sponsorship near the healing field assists in helping to accomplish the fundraising goal//).

Response to Arguments

14. Applicants arguments filed 17 August 2010 have been fully considered but have been found to be **moot** and **non-persuasive** in view of the Examiner's comments and remarks which follow. Please reference the Applicants arguments supplied in the submission filed 17 August 2010.

Regarding Argument

The Examiner respectfully disagrees. The Examiner will reiterate many of the comments presented within the Final Office Action (mail date: 16 November 2009). As stated by Applicants, the healing field **may** provide some type of visible outward

expression of the charitable cause. For example, this may be in the type of flags used, the particular arrangement or pattern in which the flags are positioned, etc. The Applicants go on to further mention that Harmon further states that "the function of funding a charity or a group of charities is ancillary to the primary function of trading items ...". Therefore, Harmon does teach and suggest the funding of a charity or a group of charities. As a preliminary matter Appellant is reminded that patents are written by and for skilled artisans. See e.g. *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) ("patents are written by and for skilled artisans"). Thus, the Examiner therefore starts with the presumption that Appellant is a skilled artisan who possess at least ordinary skill in the art. Consequently, it is the Examiner's position that because the patent references of record are directed to those with ordinary skill in this art; these references are clear, explicit, and specific as to what they teach. The Exhibit U and Harmon references, at least, when combined, teach or suggest all of the elements of independent claim 1, even as presently amended. Specifically, the Exhibit U in combination with the Harmon reference does teach that a sponsor (buyers/sellers) initially pays for an item [flag] via a graphic layout followed by selling the item to raise additional funds for a selected charity. The Exhibit U reference discloses a planned 30 acre national park and museum dedicated to the honor of the U.S. flag. (See page 1). The reference discloses plans for a "Field of Honor" containing over one-hundred granite memorial markers, as well as a "Flags of Freedom Monument" containing state and colonial flags located around 5 pools forming the shape of a star. Harmon,

however, does teach or suggest a sponsor that initially pays for a charitable event prior to its commencement, with at least a portion of proceeds being donated to the charitable cause (Harmon: Figure 2; Page 1, Paragraphs 0004-0008; Claims 1-3). Harmon allows for an option embodiment where the reselling of an item can be for a greater price and thus can be attributed to the present invention, as recited in claim 1.

Furthermore, regarding the motivation to combine the Exhibit U and Harmon prior art references, the Examiner notes that KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. [Please see KSR, 127 S. Ct. at 1741, 82 USPQ2d at 1396 for further guidance]. See also:

In re Dembiczak, 50 USPQ2d 1614 (Motivation to Combine): We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, **the knowledge of one of ordinary skill in the art**, or, in some cases, from the nature of the problem to be solved.

In re Keller, 208 USPQ 871 (CCPA 1981) (Motivation Not Found in References): [The] Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art.

As such, the Examiner maintains the rejection.

15. The arguments as filed 17 August 2010 have been fully considered but have been found to be **moot** and **non-persuasive**. As the remaining claims depend directly or indirectly from the independent claims mentioned/discusses above, the Examiner maintains all previously asserted rejections.

Conclusion

16. Applicants amendment necessitated any new grounds of rejection presented herein. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to **BENJAMIN S. FIELDS** at telephone number **571.272.9734**. The examiner can normally be reached **MONDAY THRU FRI** between the hours of **9AM** and **7PM**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KAMBIZ ABDI** can

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be reached at 571.272.6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas Dixon/

Primary Examiner, Art Unit 3684

Benjamin S. Fields

19 August 2010